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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional)	
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		10/533,245	April 29, 2005
		First Named Inventor	
		Nielsen et al.	
		Art Unit	Examiner
		2617	Phuong, Dai
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p>			
<p>I am the</p> <p><input type="checkbox"/> applicant/inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input checked="" type="checkbox"/> attorney or agent of record. 31,391 Registration number _____</p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____</p>		<p><u>Francis J. Maguire</u> Signature</p> <p>Francis J. Maguire Typed or printed name</p> <p>(203) 261-1234 Telephone number</p> <p>30-Nov-07 Date</p>	
<p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p>			
<p><input checked="" type="checkbox"/> *Total of <u>1</u> forms are submitted.</p>			

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Docket No. 915-008.034

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Re Application of: NIELSEN et al

Serial No.: 10/533,245

Examiner: Phuong, Dai

Filing Date: April 29, 2005

Group Art Unit: 2617

Title: A Communication Apparatus and a Method of Indicating Receipt of an Electronic Message, and a Server, a Method and a Computer Program Product for Providing a Computerized Icon Ordering Service

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

In response to the final Office Action mailed July 13, 2007 and the Advisory Action mailed November 1, 2007, a Notice of Appeal is filed herewith. Applicant respectfully requests a pre-appeal brief conference for reviewing the pending application.

REMARKS

Status of the Application

This application includes claims 1-38. In the final Office Action of July 13, 2007, all of the claims are rejected. With this paper, none of the claims are amended, none are added and none are canceled. A complete list of current claims can be found in Applicant's response filed on November 13, 2006.

Claim Rejections under 35 USC §102

Claims 1-4 and 18 are rejected under 35 USC §102(e) as being anticipated by Melaku *et al* (U.S. Publication 2003/0032414, Melaku hereinafter).

The invention as claimed in claim 1 is a communication apparatus. It comprises a controller, an interface adapted to receive an electronic message, a display, and a memory. The memory stores at least one predefined icon to be presented on the display so as to indicate receipt of an electronic message. The memory also stores an association between each predefined icon and a sender of electronic messages. The controller determines a sender of a received electronic message, matches the sender with a predefined icon by way of the association, and presents the matching icon, if any, on the display to indicate the receipt of the message as well as the sender of the message.

Melaku discloses a method for providing information of a calling party to a called party in the beginning of a call. The method enables an image being displayed on the called party's handset when the call arrives (e.g. during the ring tones). An embodiment of the method is shown in Figs. 2 and 4 and described in paragraphs [0024] to [0032]. Alternative embodiments are shown in Figs. 6 and 8.

Basically, Melaku's method comprises two stages. In the first stage, an SMS message including a Picture Caller Line Identification (PCLI) and a caller ID is delivered to the called party. To accomplish synchronization of the display of picture data (and other PCLI

information) with the receipt of an incoming call, the incoming call is held or suspended by the mobile switching center at the caller's side while the PCLI data is sent to the called party's mobile handset (paragraph [0034]). The called party's handset receives the SMS message, retrieves picture data from the message, and stores the picture and caller ID in a cache. At this point, the handset does not display the picture. Instead, it goes back to the original sleep mode (steps 236, 238, 240 and 242 of Fig.4, note that step 242 returns to step 236). In the second stage, after receiving an acknowledgement of the SMS message from the called party's mobile handset, the mobile switching center removes the call hold, and the call is transmitted in a normal manner. Ring tones are played. An image, which is the one included in the PCLI and saved in the cache, is displayed on the called party's handset after the second ring (Fig. 2 and step 248 of Fig. 4). Note that in Fig. 4, it is clearly shown that the picture is displayed (step 248) AFTER the incoming call notification and ONLY if the caller ID in the call matches the caller ID in the cache.

It is clear in Melaku that a message containing a PCLI header and a caller ID is transferred in conjunction with (and prior to) a phone call. The display of the PCLI image is triggered (1) upon receiving the phone call and (2) the caller ID in the phone call matches the caller ID in the SMS message. If an SMS message does not have a PCLI header, the process returns to sleep mode without displaying an image (paragraph [0040]). If an SMS message has a PCLI header, the handset retrieves the image and stores in the cache. Merely receiving an SMS message containing a PCLI header without subsequent phone call does not result in a display of the image (see Fig. 4, handset returns to sleep mode 236 after storing the picture 242).

In the present invention, on the other hand, an icon is displayed when the apparatus receives an electronic message. The electronic message does not have to be associated with a call and the electronic message does not have to have a PCLI header (for providing the image). The controller of the presently claimed apparatus is adapted to determine a sender of the received electronic message, to match the sender with a predefined icon (which is stored in the memory) by way of an association (which is also stored in the memory), and to present a matching icon, if

any, on the display to indicate receipt of the electronic message as well as the sender thereof. Therefore, in the present invention, the display of the image is **to indicate the receipt of the electronic message**, whereas in Melaku, the display of the image is **to indicate the receipt of a call** and the electronic message prior to the call is not indicated by an image.

In the final Office Action, the Examiner, in response to the Applicants previous remarks, states that:

Third, Melaku disclose in paragraph 39 to paragraph 40 that the handset 102B includes a ringer 153, a picture cache 154, a processor 151 and a display 155. When the handset 102B receives a new SMS message, the handset determines whether the message has a Picture Caller Line Identification (PCLI) header. If the message includes a PCLI header, the handset 102B extracts the PCLI header, stores in the picture cache 154 and displays to a called party (page 13, lines 12-16 of the Detailed Action, emphasis added).

Applicant respectfully submits that the above interpretation of Melaku is factually incorrect and is in clear error. As shown above, the display of the picture to the called party only occurs when a call is received and the caller ID in the call matches the caller ID in the message.

In the Advisory Action, the Examiner again disagrees with Applicant's argument that Melaku fails to teach or suggest the controller is adapted to "present a matching icon, if any, on said display to indicate receipt of said received electronic message as well as the sender thereof." In addition, the Examiner states that:

As discussed above, in one embodiment, the picture is displayed after a first ring of the handset, however, in other embodiments, the picture may be displayed at some other point in the call connection process, or after the call has been fully connected (emphasis added).

The alternative embodiments are shown in Figs. 6 and 8 of Melaku. The embodiment shown in Fig. 6 is about a landline phone to a mobile phone calling. The embodiment shown in Fig. 8 is about selecting different images for different callers when multiple callers are using the same phone. All the embodiments in Melaku include the above mentioned message delivery stage and call connection stage and none of them shows that an image is displayed after the message is delivered but before the ring tones are played. Of course, the image may be

displayed at a time later than the second ring tone, e.g. "after the call has been fully connected," but that "some other point" in the call connection stage is still a display indicating a call, not a message. It is clearly shown in both the present application and Melaku that a call and an electronic message are two different concepts, and the Examiner made clear errors by mistaking one with another in all the Official Actions.

In the final Office Action at the top of page 14, the Examiner also mentioned paragraph [0057] of Melaku in that:

Melaku discloses in paragraph 57 that in order to providing identification of a user, a user may select a particular PCLI image to use each time a call is made. The selection of the particular image may be made by pressing a key in response to a prompt or by uttering a particular phrase. ... Therefore, it is inherent that Melaku discloses to use images to indicate a sender of an electronic image (Page 14, lines 1-8 of the Detailed Action, emphasis added).

The above underlined statement is factually incorrect and constitutes a clear error. In fact, paragraph [0057] only discloses a sending user selecting an image to be used in the PCLI header each time a call is made. However, selecting an image for the PCLI is a procedure performed by the sending party. The receiving party is only configured to display the PCLI image included in the message when a subsequent call arrives and the caller ID in the call matches the caller ID in the message. In the present invention, the icons are predefined and stored in the receiving party's handset with associations between each image and a sender. That means if a received electronic message does not have a PCLI header, the receiving party may still display an image representing the sender because the image is predefined and stored locally.

Based on the above, the present invention is not anticipated by Melaku. The section 102 rejection is based on a clearly erroneous interpretation of what Melaku actually teaches. Applicant respectfully requests the rejection of claim 1, and dependent claims 2-4 and 18, be withdrawn and the claims proceed to allowance.

Claim Rejections under 35 USC §103

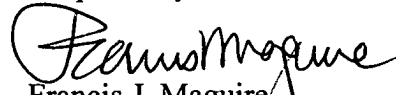
Other claims not mentioned in the preceding section are rejected under 35 USC 103(a) as being unpatentable over Melaku in view of various other references. In these claims, only claim 19 is independent, and claim 19 is rejected for the same reason as set forth in claim 1 (page 11, line 5 of the Detailed Action).

Since claim 1 is believed to be patentable for the reasons presented in the preceding section, claim 19 is also patentable. All other claims are also patentable due to their dependency to a patentable independent claim. Applicant respectfully requests the claim rejections under 35 USC §103 be withdrawn and the claims proceed to allowance.

Conclusion

For all the foregoing reasons, it is believed that all of the claims of the application are allowable. Applicant's attorney urges the Examiner to call to discuss the present response if anything in the present response is unclear or unpersuasive.

Respectfully submitted,


Francis J. Maguire
Attorney for the Applicant
Registration No. 31,391

WARE, FRESSOLA, VAN DER SLUYS
& ADOLPHSON LLP
755 Main Street, P.O. Box 224
Monroe, Connecticut 06468
(203) 261-1234